Buckley 790105-1
08-06-05

REMARKS

In response to the Office Action mailed July 18, 2005, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file and as originally filed in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

Rejections

Rejections Under 35 USC §103

Claims 1-19 have been rejected under 35 U.S.C. §103 (a) over U.S. Patent No. 5,915,637 hereinafter called (the ***Parsons reference***) in view of U.S. Patent No. 3,618,751 hereinafter called (the ***Rich reference***). Applicant respectfully traverses these rejections for the following reasons.

Applicant respectfully asserts that the Examiner has not stated a proper *prima facie* case of obviousness in support of the rejections of claims 1-19 for the following reasons. Because a proper prima facie case for obviousness is absent, Applicant does not at this time offer rebuttal evidence of nonobviousness for the rejected claims 1-19.

According to the Manual for Patent Examining Procedure (MPEP) § 2142, a proper prima facie case of obviousness can be established only when all of three basic criteria ("prongs") are met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. ***In re Vaeck, 947 F2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).***

In rejecting claims 1-19 for alleged obviousness over the cited references, the examiner has not met the legal requirements cited in ***In re Vaeck, supra.*** Before discussing why the examiner has not met such legal requirements, it will be helpful to first review the two references cited by the examiner in forming the rejection.

The ***Parsons reference*** discloses a pill crusher that utilizes a pouch that receives a pill to be crushed. The pouch as shown in FIG. 6 of the Parsons reference is formed from a single sheet of transparent flexible sheet material such as polyethylene. The sheet is formed in a conventional manner to provide pouch sides, such as sides 51, a front panel 53 and a back panel 53a and a sealed bottom 55. A minor panel 52, an integral part of the front panel 53 is folded over and sealed against the back panel 53a at a straight seal line 57 to provide a leak tight container. The aforementioned panels are unsealed at their tops and an opening 58 is, thus presented. (See Col. 4, lines 27 et seq.).

The ***Rich reference*** discloses a disposable self-contained device in a variety of different forms for crushing and administering pills in powder form in which a crushing surface is sealed within an envelope-like pouch formed from a tray base member and a

plastic film sealed to the edges thereof, which tray contains a spoon and an edible gel in a depression, so that part of the film can be torn, a pill can be inserted into the envelope pouch and then crushed by an external crushing force. The rest of the film is removed and the pill power is then transferred to and mixed with the edible gel, and then dispensed to the patient by the spoon which is shaped so as to mated with the depression containing the edible gel and power, so the patient easily can swallow substantially all the pill powder that has been mixed with the gel. The spoon is formed of a hard plastic material.

Considering now the deficiencies of the examiner's rejection relative to legal requirements cited by ***In re Vaeck, supra.*** Regarding the first prong, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The Examiner recites no evidence or suggestion for such combination from the prior art, despite the several motivating advantages of the combination discussed by Applicant in the present application. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure **[In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 9Fed. Cir. (1991)].** Moreover, The level of skill in the art cannot be relied upon to provided the suggestion to combine references {Al-Site Corp. V. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)}. Thus, Applicant respectfully asserts that there is not suggestion from combining elements from the ***Parsons reference*** and the ***Rich reference***, even in view of the present application. Neither the ***Parsons reference*** nor the ***Rich reference*** consider or suggest such a combination; in fact, the ***Parsons reference*** considers only a pouch with a square corner seal line while the ***Rich reference*** does not discuss any aspect of a pouch whatsoever except relative to tray base member and the plastic film sealed to the edges of the tray base member. The ***Rich reference*** directs most of its disclosure to transferring a crushed pill into a hard plastic spoon, which is an eating utensil, not a

flexible pouch. There clearly is nothing in either of these references that would lead one skilled in the art to combine the pouch as taught by the ***Parsons reference*** with the hard spoon like instrument as taught by the ***Rich reference*** to arrive at a pouch with a "front panel and said back panel being sealed together along a cup line seal line disposed at a base portion of said front panel and said back panel to provide an open pouch with a closed bottom and an open top....". Even hindsight of having the opportunity to read the present patent application, would not lead one to combine these references as suggested by the examiner. Accordingly, the present office action of does not support the first prong of a proper *prima facie* case of obviousness.

Regarding the second prong, Applicant can find no discussion of the likelihood of success (as found in the prior art) in the present office action and therefore Applicant respectfully asserts that the office action does not support the second prong for a proper prima facie case of obviousness.

Regarding the third prong, even when combined, the ***Parsons reference*** and the ***Rich reference*** do not anticipate every element of Applicant's invention as claims in claim 1. Claim 1 as originally filed is directed to a "single sheet of flexible material" with "a cup like seal line" that is "disposed at a base portion of said front panel and said back panel to provide an open pouch with a closed bottom and an open top...". Thus, Applicants invention provides a pill crusher pouch where the "cup like seal line" provides the "open pouch with a cornerless smooth rounded interior bottom to facilitate easy pouring of pulverized pill residue from the interior of the open pouch." The ***Rich reference*** as noted earlier is directed to a hard spoon utensil and does not consider a flexible pouch. In fact, the ***Rich reference*** at Col. 6, lines 51 et seq. when disclosing the materials of construction for the spoon provides, "a spoon having a bowl and a handle portion, is preferably made of a **hard styrene rubber** ...."(emphasis added), which clearly teaches away from a combination "single sheet of flexible material", with

"a cup-like seal line". The only seal discussed in the ***Rich reference*** is the sealing of the plastic film to the tray member, which seal clearly does not have a cup-like shape.

More specifically, the examiner has not cited any motivation set forth in the ***Parsons reference or in the Rich reference*** or in knowledge generally available to one of ordinary skill in the art, to modify the in the ***Parsons reference and the Rich reference*** in the manner suggested by the examiner relative to the cited prior art as proposed or suggested by the examiner. The examiner has simply made the conclusary statement that "Rich discloses a similar article including several embodiments in which a pill crusher pouch has a cup-like bottom", referencing FIGS. 13 and 18. FIGS 13 and 18 both illustrate a hard plastic spoon with a flexible peel sheet not "a single sheet of flexible sheet material folded upon itself and sealed along a longitudinal edge portion thereof to form an open pouch having a front panel and an back panel..." nor "a seal line providing an open pouch with a cornerless smooth rounded interior bottom".

For the foregoing reasons, withdrawal of the obviousness rejection of claims 1-19 over the combination of the cited prior art is requested.

Conclusion

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition

for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned

Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: August 6, 2005

Respectfully submitted,

Law Office of Jerry R. Potts & Associates

By : _____
Jerry R. Potts
Attorney for Applicant
Registration No. 27,095

JERRY R. POTTS & ASSOCIATES
3248 Via Ribera
Escondido, California 92029
Telephone: 760-822-6201

THIS PAGE BLANK (USPTO)